

Remarks

Claims 35-59 are pending. Claims 35-42 are withdrawn. Claim 43 has been amended. Claims 51-59 have been newly added. Support for claim 51 can be found on page 15, lines 20-23, and on page 16, lines 4-19, for example. Support for claims 52 and 53 can be found on page 16, line 8, for example. Support for claims 54-57 can be found on page 10, lines 20-30, for example. Support for claim 58 can be found on page 10, lines 20-21, for example. Support for claim 59 can be found on page 18, lines 18-20, for example.

The Office Action requires restriction to one of the following two groups of claims:

Group I: Claims 35-42, drawn to a method of detecting cancer.

Group II: Claims 43-50, drawn to a method of classifying a cancer as being correlated with increased expression of erbB-3.

As required in response to this Action, applicants provisionally elect Group II (claims 43-50), with traverse. Applicants also request that newly added claims 51-59 also be examined with this group, as these claims depend from claim 43.

Claims 35-59 all claim methods of detecting and classifying cancer. Furthermore, the steps of the methods of the two groups are nearly identical, as each requires a step of a) measuring a level of expression of an erbB-3 gene; and b) comparing the level of expression of the erbB-3 gene in the sample from the subject to a level of expression of the erbB-3 gene in a sample from a control subject. Therefore, there is not an increased burden on the office to examine these groups together.

The Examiner has also requested that several species elections be made. The first is

between detection of a) protein expression, b) mRNA expression, and c) genomic expression.

The second is between a sample of either a) a tumor sample or b) a body fluid sample. The third species election is between detection of a) breast cancer or b) another type of cancer as outlined in the specification.

The MPEP, Section 803.02, teaches that, “Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.”

All three of the first species election share a common utility, in that they are used in the methods of detection or classification, and share a substantial structural feature, in that they are all detectable by the methods of the generic claims.

In the case of the second species election requirement regarding the sample arising from a body fluid versus a tumor sample, again, these clearly share the same utility, as both are used to detect or classify cancer. They also share a substantial structural feature, as they both contain the markers necessary to detect and classify cancer.

In the third case, again, the generic claims are drawn to methods of detecting and classifying cancer. Because the generic claim is just that, generic, it covers multiple types of cancer, including breast cancer. To force applicants to pick one type of cancer that can be

detected, when the method is generic to multiple types of cancer, is improper and out of line with the practices outlined in the MPEP. Furthermore, breast cancer and other forms of cancer share the same utility, as all types of cancer do. And they clearly share the same substantial structural feature, as all forms of cancer comprise markers which can be detected.

Because the Office requires election of a single species, applicants herein elect from the first group, protein expression; from the second group, tumor samples; and from the third group, breast cancer.

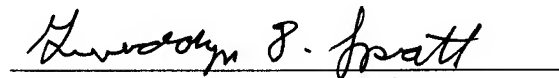
For the reasons stated above, applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Thus, applicants respectfully request that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Applicants also wish to remind the Examiner of the guidelines for rejoinder of claims as set forth in M.P.E.P. § 821.04, as they apply to the pending claims of the instant application.

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No additional fee is believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

A handwritten signature in cursive script, reading "Gwendolyn D. Spratt", is written over a horizontal line.

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